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Rudolf Linde

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EXAMINER

WONG, EDNA

ART UNIT

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MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

Response to Amendment

This is in response to the Amendment After Final dated September 30, 2008.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Response to Arguments

Claim Rejections - 35 USC § 112

Claims **10-15** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 10-15 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 103

Claims **10-15** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Gardam** ("The Production of Machinable Cr Deposits", *J. of the Electrodepositors' Technical Soc.* (1945), Vol. 20, pp. 69-74) in combination with **DE 44 32 512** ('512), **EP 1,205,582** ('582), **Horsthemke** (US Patent No. 6,837,981 B2) and **Wilmeth et al.** (US Patent No. 5,196,108).

The rejection of claims 10-15 under 35 U.S.C. 103(a) as being unpatentable over

Gardam in combination with DE 44 32 512 ('512), EP 1,205,582 ('582), Horsthemke and Wilmeth et al. is as applied in the Office Actions dated February 28, 2008 and July 30, 2008 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that the Examiner has not yet presented a reference teaching a "hard chrome layer compris[ing] at least one of a cup-shaped structure, a labyrinth structure, or a column-shaped structure," as included in the claims. As such, a *prima facie* case of obviousness has not been met, as references teaching or suggesting such a feature have not been presented.

In response, the "hard chrome layer compris[ing] at least one of a cup-shaped structure, a labyrinth structure, or a column-shaped structure," is not a method step. In method claims, it is the overall method steps that are given patentable weight not the intended result limitations thereof. The intended result limitations in the present claims do not materially alter the overall method.

Where Applicants claim a process in terms of a function, property or characteristic and the process of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, Applicants should point out the manufacturing process steps that would be expected to impart the distinctive structural characteristics to the final product.

Furthermore, the "wherein ... such that" clause in a method claim is not given patentable weight when it simply expresses the intended result of a process step

positively recited (MPEP § 2111.04).

Furthermore, the Examiner maintains that the Applicant has a different reason for, or advantage resulting from doing what the prior art relied upon has suggested, it is noted that it is well settled that this is not demonstrative of nonobviousness. *In re Kronig* 190 USPQ 425, 428 (CCPA 1976); *In re Linter* 173 USPQ 560 (CCPA 1972); the prior art motivation or advantage may be different than that of Applicants while still supporting a conclusion of obviousness. *In re Wiseman* 201 USPQ 658 (CCPA 1979); *Ex parte Obiaya* 227 USPQ 58 (Bd. of App. 1985) and MPEP § 2144.

Applicants state that the Examiner has shown no motivation to modify the Gardam reference as the Examiner has suggested. There is no rational, articulated reason provided to look at a reference directed to the formation of soft chromium layers when hard chromium layers are desired.

Applicants state that there is no suggestion or motivation to add the missing electrolyte components to Gardam. The Examiner has not made out a *prima facie* case of obviousness.

In response, it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught by the prior art (MPEP § 2144.06).

A reference is reasonable pertinent if, even though it may be in a different field

from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem (MPEP § 2141.01(a)).

Applicants state that none of the references teaches the desire for a cathodic current efficiency of 12% or less, and hence teach away from the instant application.

In response, Gardam teaches a cathodic current yield of 12% or less (page 72, line 11 to page 73, line 2; and Fig. 3).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied*, 469 U.S. 851 (1984). Further, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See MPEP §§ 2123 and 2141.02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDNA WONG whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edna Wong/
Primary Examiner
Art Unit 1795

EW
October 2, 2008